

### REMARKS

New claims 113 and 114 have been added. Support for these new claims exists throughout the specification including the examples such as, for example, at page 3, lines 11-18 and page 23, line 10.

Claims 2-27, 31-42, 44-51, 53-58, 60-78, 81-95 and 101-103, 105-107 and 109-114 are currently pending, although claims 53-57, 60 and 61 have been withdrawn from consideration. Because the withdrawn claims ultimately depend from non-withdrawn claims, Applicant respectfully requests rejoinder of the withdrawn claims pursuant to MPEP § 821.04.

The Office Action rejected the pending claims under 35 U.S.C. §103 as obvious over EP 0548694 ("Nojima") in view of U.S. patent 5,738,841 ("Mellul") alone or in combination with U.S. patent 5,690,918 ("Jacks") or JP 63119412 ("JP 412"). In maintaining these rejections, the Office Action asserted that because the claims contain the transition phrase "comprising," alkoxylated silicone compounds are not excluded from the claimed compositions, meaning that the claimed invention does not differ from Nojima even though Nojima requires the presence of alkoxylated silicone compounds in his compositions. In view of the following remarks, Applicant respectfully requests reconsideration and withdrawal of these rejections.

Nojima requires the presence of alkoxylated silicone compounds. In sharp contrast, all of the pending claims exclude the presence of alkoxylated silicone compounds. That is, by virtue of (1) the language in the present claims requiring the non-volatile silicone component to "consist of" the specified non-volatile silicone compounds, meaning that the only non-volatile silicone compounds which may be present in the claimed compositions are those identified in the claims; and (2) the fact

that the specified non-volatile silicone compounds do not include alkoxyated silicone compounds, the claims require the presence of a non-volatile silicone component which does not include alkoxyated silicone compounds. Because Nojima requires the presence of alkoxyated silicone compounds, Nojima cannot teach or suggest the claimed silicone component, meaning that Nojima cannot teach or suggest the claimed invention.

This is particularly true for new claims 113 and 114 which expressly prohibit the presence of alkoxyated silicone compounds in the claimed compositions.

Mellul cannot compensate for Nojima's deficiencies. First, Mellul provides no motivation to modify Nojima's compositions to yield the invention compositions. As noted above, Nojima requires the presence of alkoxyated silicones. Mellul, on the other hand, is directed to "surprisingly" homogenous mixtures of octyldodecyl neopentanoate and "at least one silicone-containing compound which may be chosen from silicone oils, gums and/or waxes." (Col. 2, lines 48-49). Mellul neither teaches nor suggests that her silicones could be alkoxyated and, in fact, teaches away from such alkoxyated silicones by identifying only non-alkoxyated silicones as being suitable for combination with octyldodecyl neopentanoate. (Col. 2, line 49 through col. 3, line 6). One skilled in the art, following the teachings of both of these references, would not have been motivated to combine them given the highly specific nature of their disclosures: Nojima relates only to alkoxyated silicones, while Mellul relates to "surprisingly" homogeneous compositions containing non-alkoxyated silicones. Given the specificity of their disclosures, nothing in either of these references would have suggested that non-alkoxyated silicones could be used in

Nojima's compositions or that alkoxyated silicones could be used in Mellul's compositions to yield a "surprisingly" homogeneous composition.

Second, Mellul does not relate to transfer-resistant compositions, let alone transfer-resistant lipsticks. Rather, Mellul discloses non-transfer-resistant compositions containing 0% inert particulate phase or 48% or more inert particulate phase,<sup>1</sup> and teaches that volatile silicone oils are interchangeable with non-volatile silicone compounds. (See, col. 2, line 51). One skilled in the art, seeking to produce a composition addressing appearance and sensation problems associated with transfer-resistant compositions, particularly lipsticks, would not be motivated by Mellul to selectively combine the required ingredients in the required proportions with the expectation that the resulting composition would be a transfer-resistant composition, particularly a transfer-resistant composition having desirable properties such as not having a matte appearance or a sensation of dryness, tautness and/or discomfort.

Neither Jacks nor JP 412 suggests modifying Nojima's compositions to yield the claimed invention. Jacks requires the presence of too much volatile oil, so it cannot teach or suggest the claimed compositions having little or no volatile oil. JP 412, which is cited merely for its disclosure relating to 12-hydroxystearic acids, cannot compensate for Nojima's deficiencies as well.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103.

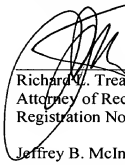
Applicant believes that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

---

<sup>1</sup> In this regard, Applicant notes that pigments do not constitute fillers/inert particulate phase. (See, specification at pages 20 and 21; Mellul at col. 2, line 43).

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



---

Richard W. Treahor  
Attorney of Record  
Registration No. 36,379

Jeffrey B. McIntyre  
Registration No. 36,867

Customer Number

**22850**

Tel #: (703) 413-3000  
Fax #: (703) 413-2220